

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Kozuka et al.	Art Unit :	3753
Patent No. :	7,578,313	Examiner :	John A. Rivell
Issue Date :	August 25, 2009	Conf. No. :	9214
Serial No. :	10/800,794		
Filed :	March 15, 2004		
Title :	ROTARY PILOT VALVE		

Commissioner for Patents
P.O. Box 1450
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 445 days to 883 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the

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failure of the United States Patent and Trademark Office to issue a patent within 3 years.”

“B delay” begins only after the PTO has failed to issue a patent within three years, not before.

Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before May 15, 2005 (the date that is fourteen months after March 15, 2004, the date on which the application was filed). The PTO mailed the first non-final Office Action on August 17, 2006, thereby according a PTO Delay of 459 days. Patentees do not dispute the PTO's calculation for this “A Delay” from May 16, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to August 17, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before May 7, 2008 (the date that is four months after January 7, 2008, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on December 15, 2008, thereby according a PTO Delay of 222 days. Patentees do not dispute the PTO's calculation for this “A Delay” from May 8, 2008 (the day after the date that is four months after the date on which a response to Office Action was filed), to December 15, 2008. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 681 days (i.e., the sum of 459 days and 222 days).

“B Delay”

The period beginning on March 16, 2007 (the day after the date that is three years after March 15, 2004, the date on which the application was filed), and ending August 25, 2009 (the date the patent was issued), is 894 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, no Request for Continued Examination was filed. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed.
See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 894 days. The PTO calculated 213 days of delay for issuance of a patent more than three years after filing. Patentees respectfully submit that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 894 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following periods:

May 16, 2005, to August 17, 2006; and

May 8, 2008, to December 15, 2008.

As detailed above, "B Delay" accumulated during the following period:

March 16, 2007, to August 25, 2009.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day), for a total of 222 days, from May 8, 2008, to December 15, 2008.

Applicant Delay

A reply to an Office Action was due on or before November 17, 2006 (the date that is three months after August 17, 2006, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on January 7, 2008, thereby according an Applicant Delay of 416 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from November 18, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to January 7, 2008. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before March 15, 2009 (the date that is three months after December 15, 2008, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on March 16, 2009, thereby according an Applicant Delay

of 1 day. Patentees do not dispute the PTO's calculation for this Applicant Delay from March 16, 2009 (the day after the date that is three months after the date on which the Office Action was mailed), to March 16, 2009. See 37 C.F.R. § 1.704(b).

Patentees filed a Supplemental Reply on April 17, 2009, subsequent to a reply filed on March 16, 2009. Patentees were accorded a delay of 32 days for a supplemental response. Patentees do not dispute the PTO's calculation for this Applicant Delay from March 17, 2009, to April 17, 2009. See 37 C.F.R. § 1.704(c)(8).

Patentees filed an Interview Summary on May 8, 2009, subsequent to a reply filed on April 17, 2009. No Applicant Delay was accorded for this reply; however, in good faith and candor, Patentees respectfully submit that the Interview Summary should have been accorded a total Applicant Delay of 21 days for delay from April 18, 2009, to May 8, 2009. See 37 C.F.R. § 1.704(c)(8).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 470 days (i.e., the sum of 416 days, 1 day, 32 days and 21 days).

Terminal Disclaimer

This patent is subject to a terminal disclaimer. No expiration date was specified in the terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 445 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1353 days (i.e., the sum of 681 days of "A Delay" and 894 days of "B Delay" minus 222 days overlapping delay);
- 2) Total Applicant Delay should be calculated as 470 days (i.e., the sum of 416 days, 1 day, 32 days and 21 days); and
- 3) Total PTA should be calculated as 883 days.

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The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 23697-0041001.

Respectfully submitted,

Date: October 26, 2009

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